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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,413	08/15/2003	George Y. Huang	Huang/Cont Raised Port	3476
26860	7590	09/09/2004	EXAMINER	
LAW OFFICE OF DUNCAN PALMATIER 530 SOUTH ASBURY SUITE 5 MOSCOW, ID 83843			TSUKERMAN, LARISA Z	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,413

Applicant(s)

HUANG, GEORGE Y.

Examiner

Larisa Z Tsukerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/07/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § U.S.C. 102

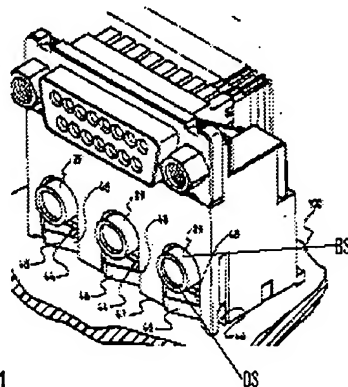
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tan et al. (5735699).

Tan et al. disclose the device 10 comprises the housing 16 with an outer surface and at least one end 20 adapted to hold an electrical connector plug, wherein the housing 16 has a raised portion 29 above the outer surface of the housing 16, a covering 12 formed over the outer surface of the housing 16 and around the raised portion 29, and an exposed part of the raised portion 29 is not covered by the covering 12 (see Fig. 3); the exposed part of the raised portion further comprises a background surface BS and a design surface DS, and the design surface is formed as part of the background surface and is not level with the background surface (see Attachment 1).



Attachment 1

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Owens et al. (4,704,091).

Owens et al. disclose the device comprises the housing 12 with an outer surface and at least one end adapted to hold an electrical connector plug, wherein the housing 12 has a raised portion 26 above the outer surface of the housing, a covering 14 formed over the outer surface of the housing 12 and around the raised portion 26, and an exposed part of the raised portion 26 is not covered by the covering; the exposed part of the raised portion further comprises a background surface and a design surface, and the design surface is formed as part of the background surface and is not level with the background surface.

Owens et al. do not discuss the exposed part of the raised portion 26 forms a **background surface** and a **design surface**; and the design surface is formed as part of the background surface and is not level with the background surface. However, matters relating to **ornamentation only which have no mechanical function** cannot be relied upon to **patentably distinguish** the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 - 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091).

In regard to **claims 3 and 14**, Owens et al. disclose most of the claimed invention except for a **design surface** is a sub-surface design **below** the background surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form a **design surface** is a sub-surface design **below** the background surface, since applicant has not disclosed that this limitation solve any stated problem or are for any particular purpose and it appears that the invention would perform equally well with or without a **design surface** formed as a sub-surface design **below** the background surface.

In regard to **claims 4 - 6**, it is noted that these claims are "product by process" claims, the method of forming an **ornamentation** structure is not given significant patentable weight in claim where said method does not impart any structural limitation. It is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art (in this case – Owens et al.), cannot impart (grant) patentability to the product. *In re Johnson*, 157 USPQ 670, 1968

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091).

Owens et al. disclose most of the claimed invention except for a **design surface** is a sub-surface design surface formed in the background surface is an **above** – surface design above the background surface.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to form a **design surface** as an **above** – surface design above the background surface, since applicant has not disclosed that this limitation solve any stated problem or are for any particular purpose and it appears that the invention would perform equally well with or without a **design surface** formed as an **above** – surface design above the background surface.

In regard to claims 8 - 10, it is noted that these claims are “product by process” claims, the method of forming an **ornamentation** structure is not given significant patentable weight in claim where said method does not impart any structural limitation.

It is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art (in this case – Owens et al.), cannot impart (grant) patentability to the product. *In re Johnson*, 157 USPQ 670, 1968

Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Wiebe (4164725).

Owens et al. disclose most of the claimed invention except for a **design surface** formed in the background surface is **gripping** surface design. Wiebe teaches a gripping surface 72 to permit one to better grip the component 20.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a **design surface** as a **gripping** surface to permit one to better grip the connector and also for better connection with an information plug 26 (affixed) which is designed as identification plaque (see Col.3, line 55) and used for putting information on.

Response to Arguments

Applicant's arguments filed 6/07/04 have been fully considered but they are not persuasive.

In response to Applicant's arguments regarding rejection of claims 1 and 12 under 35 USC 102:

first of all, Tan et al. clearly discloses that the housing 16 has a raised portion 29 that is above the outer of the housing 16;

secondly, applicant's claim language is so broad and it does not clearly defined the "background surface" and the "design surface, further Applicant does not claim a "design surface providing a location for indicia", such as color, symbol, etc. Therefore, Examiner's interpretation thus any surface of the exposed part of the raised portion 29 would read as the "background surface" and the "design surface".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larisa Z Tsukerman whose telephone number is (571)-272-2015. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A Bradley can be reached on (571)-272-2800 ex. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LT
08/13/2004


THO D. TA
PRIMARY EXAMINER